

Applicants: Dean Engelhardt et al.
Serial No.: 08/486,066
Filed: June 7, 1995
Page 3 (Amendment - December 23, 1997)

REMARKS

Reconsideration of this application is respectfully requested. Claims 238-297 and 299-338 are pending in the subject application. No claims have been added or deleted from the application and claims 238, 272, and 308 have been amended hereinabove.

As discussed above, Applicants hereby elect to exercise the provisions of 37 CFR §1.129(a) and enclose the required fee under 37 CFR §1.17(r) for this election. Under the provisions of the recited rule, Applicants are entitled to have the finality of the June 23, 1997 Office Action withdrawn and have the present amendment entered and considered on the merits.

In the June 23 Office Action, the Examiner recites a paragraph regarding priority under 35 U.S.C. §120. Applicants are unsure whether this recital is meant to imply that priority has not been claimed in the present application. If so, Applicants direct the Examiner's attention to the Preliminary Amendment filed on September 11, 1995 in which cross reference was added to related applications from which priority is claimed. Presently, priority is claimed back to US Serial No. 06/391,440 filed June 23, 1982. If the Examiner believes that Applicants' claim to priority is incomplete, Applicants request that they be so advised.

The Examiner rejected claims 238-297 and 299-338 under 35 U.S.C. § 112, first paragraph, alleging that the disclosure is only enabling for claims limited to covalent attachment of the SIG or PM moieties to the sugar via hydroxyls at the 2', 3', or 5' position of ribose or deoxyribose sugars. Although Applicants disagree with the Examiner's position, they have, nevertheless, amended claims 238, 272, and 308 (the independent claims pending in the subject application) so that they are restricted to sugar moieties comprising a ribose or deoxyribose. In light of this amendment, Applicants believe that the rejection under 35 U.S.C. §112, first paragraph, is now moot and request withdrawal of the rejection.

The Examiner also rejected various combinations of the claims under 35 U.S.C. § 102(a) as anticipated by Caruthers (1982) or under 35 U.S.C. §102 (b) as anticipated by Kourilsky et al (Great Britain Patent No. 2,019,408).

Applicants disagree with the Examiner's position and maintain that the presently claimed invention, as amended hereinabove, is patentable over the cited references. Applicants are in the process of evaluating whether to submit a declaration under 37 CFR §1.131 for removal of the Caruthers (1982) reference and/or declarations under 37 CFR §1.132 to support their position of

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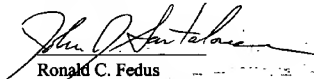
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Page 4 (Amendment - December 23, 1997)

patentability over the cited references. The declarations, if any, as well as additional remarks regarding Applicants' position will be submitted in a supplemental amendment shortly. In the meantime, Applicants request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §102.

In light of the above, Applicants respectfully request withdrawal of the various rejections set forth in the June 23, 1997 Office Action. If a telephone conversation would further the prosecution of the present application, Applicants' undersigned attorney requests that he be contacted at the number provided below.

A \$950 fee for a three month extension of time and \$790 fee for filing a submission after final rejection under 37 CFR §1.129(a) is due in connection with this response. Authorization is hereby given to charge these fees to Deposit Account No. 05-1135. If any other fee is deemed necessary, authorization is hereby given to charge the amount of such fee to Deposit Account No. 05-1135.

Respectfully,



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